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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,732	06/28/2001	Noboru Iwayama	1405.1045	3572

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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/892,732

Applicant(s)

IWAYAMA ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/28/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/28/01
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**09892732 DETAILED ACTION**

1. This Office Action is responsive to the original application . Claims 1-11 are pending. Claims 1, 2, 9, 10, and 11 are independent.

***112 Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 2-4, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 2 at page 53, from “advertising acceptance means ...” on to “storing ...by said advertising acceptance means “ is very confusing. Clarification is required.

Claim 3 at page 54 is equally confusing. It is interpreted that the owners of the ads, registered or not, and their addresses, need to be asked for their permission to correlate ads to content URL’s . Clarification is required.

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Claim 4 : “said advertising database means... with the unregistered advertising information” is incomprehensible. Clarification/correction is required. it is interpreted for art application purposes that detailed ads are correlated to some ads .

Claim 11: most of page 60 is incomprehensible. it is not clear who is rewarded, the first user, the second or both. It is interpreted that both are. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over LiQ, Inc. Makes Gift-Giving Easier with Online-paging. Shop and Chat Technology lets Consumers make decisions Together , Business Wire, Dec. 21, 1999, herein LiQ-Paging, in view of DIALOG(R)File 640, record # 10719046, BIG BUDDY IS WATCHING YOU San Francisco Chronicle (SF) - SUNDAY, August 6, 2000 By: Cheryll Aimee Barron, herein Barron.**

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As to claim 1, 9,10, all steps, (and implicit computer programs/devices), except the step of sending an ad associated with browsing from a first user to a second on-line user as ‘status of the first user’ such as

- interconnection of the 1<sup>st</sup> and 2<sup>nd</sup> users,
- the 2<sup>nd</sup> user checking on status of 1<sup>st</sup> user,
- a database of ads correlated to some content URL’s
- detecting URL’s used by the 1<sup>st</sup> user
- extracting ads corresponding to URL’s used by 1<sup>st</sup> user

are admitted art (see at least Specifications pages 2-3).

As to sending an ad associated with browsing from a first user to a second on-line user as ‘status of the first user’, a “status” message is any message.

LiQ-Paging discloses shopping buddies logged on at LiQ.com are paged privately when their buddies are shopping and invited to join into private chatrooms to see products for together shopping. Thus the 2<sup>nd</sup> user of the LiQ system implicitly gets a message about the status of a first user, about a content being a page viewed by the first user.

Further Barron discloses an instant message system and software where someone notes when a page was viewed by a buddy on line and sends comments. Thus Barron teaches that the 2<sup>nd</sup> user is notified of the particular page viewed by the first user.

It would have been obvious to one skilled in the art at the time the invention was made to add Big Buddy to LiQ-Paging to allow the 2<sup>nd</sup> user to view the page viewed by the first user for together shopping as taught by LiQ-Paging.

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Further it is well-known at invention time that many ads are associated with each product/service/information webpage for cross- or up-selling purposes. Therefore it would have been obvious to one skilled in the art at the time the invention was made to send an ad associated with the page viewed to the first user to the second user as well to effect cross- or up-selling to the second user as well.

As to claims 2-4, Official Notice is taken that the following facts are well-known:

accepting ads from advertisers, correlating them to certain content URL's with their permission and communicating with the advertisers (ad owners) using their addresses are obvious and well-known business methods.

Thus it would have been obvious to one skilled in the art at the time the invention was made to add these methods to the system of LiQ-Page/ Barron above effect the system of LiQ-Page/ Barron according to well-accepted business methods.

**6. Claims 5-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over LiQ-Paging and Barron as applied to claim 4 above, and further in view of Goldhaber et al., US 5,794,210.**

As to claim 5-8,  
the steps of a user requesting detailed information associated with the ad sent, returning the detailed information if available, monitoring access to the ads detailed information from the user, setting awards conditions set for the user based on access to ads, doling out awards as earned, monitoring access counts to detailed ads information, calculating fees to charge advertisers based on the user access are all disclosed either in Goldhaber (see at least abstract, Figs. 1-15 and associated text) or as admitted art in the Specifications (see at least pages 2-3).

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It would have been obvious to one skilled in the art at the time the invention was made to add the methods of ad viewing rewards and charging of advertisers taught Goldhaber or admitted, to the advertising system/method of LiQ-Page/ Barron to effect the ad compensation/ charge scheme as taught by Goldhaber or admittedly known, to further encourage ad viewing.

Claim 11 is interpreted as a combination of claims 1-8 wherein the incentives may be for both 1<sup>st</sup> and 2<sup>nd</sup> user. It would have been obvious to one skilled in the art at the time the invention was made, in view of the LiQ-Page/ Barron system of connected shopping together users and in view of Goldhaber's compensation scheme, to add rewarding both users to the LiQ-Page/ Barron system, so more ads can be viewed by more consumers.

### **Conclusion**

7. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Porter, US 6434599 B1, discloses method for on-line chatting.

DIALOG(R)File 621, record# 02244691 LiQ Inc. Pioneers a New Form of Online Shopping With the Launch of LiQ.com; Unique Shop & Chat Technology Allows Customers to Shop Together Online .

Business Wire, p1496, Nov 30, 1999

discloses the launch of www.LiQ the new consumer portal Web site for "social shopping: the "Shop & Chat"technology that allows customers to Shop Together (TM) online .Customers can bring items into private chatrooms to show and discuss with friends, choosing among more

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than four million products from over 400 merchants. This patent-pending Shop & Chat feature is extremely helpful for people buying gifts together for relatives or mutual friends.

DIALOG(R)File 621: record # 02268800 LiQ.com Reaches Milestone of 10,000 Registered Users; E-Commerce Pioneer Sees Accelerating Growth for Online Social Shopping, Business Wire, p1169, Dec 28, 1999

discloses technology represents a new mode of e-tailing called Social Shopping(tm), which LiQ, Inc. has pioneered. The service provides a simple way for shoppers to bring products into private chatrooms for viewing and

discussion with family members or friends.... extending the functionality of Shop Together to include new features like online paging.

DIALOG(R)File 15, Record # 01952390 Land's End site lets pairs shop online by Rosier, Ben, Marketing PP: 4 Nov 4, 1999

discloses Lands End is to launch

its first e-commerce site in the UK next week. The site will feature

special software which allows pairs of consumers to shop together

online, regardless of their location. Land's End with a phone call paid for by the company.

DIALOG(R)File 9, Record # 2512389 NetGravity to serve FriendFactory ads( FriendFactory signed up NetGravity's AdServer technology to provide and monitor its direct marketing service E-Notes and serve banners over the site) by Amy Vickers, New Media Age, p 5, June 17, 1999

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is (703) 305-0571. The examiner is on flexible schedule and can normally be reached on Tuesday-Wednesday from 9:00 AM - 6:00 PM. The examiner can also be reached at the e-mail address: [khanh.le2@uspto.gov](mailto:khanh.le2@uspto.gov)



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469.

The Official Fax Numbers for TC 3600

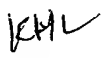
Before Final: 703-872-9326

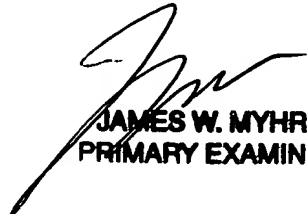
After Final: 703-872-9327

Customer Service: 703-872-9325

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-308-1113.

December 10, 2004

  
Khanh H. Le

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**